



**UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/286,678 | 04/02/99 | LEUNG | P ST9-95-032R |

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EXAMINER

KULIK, P

ART UNIT

PAPER NUMBER

2777

3

DATE MAILED:

02/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/286,678

Applicant(s)

Leung et al.

Examiner

Kulik

Group Art Unit

2777

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 (THREE) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on April 2, 1999.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - 69 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 69 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 2777

1. This application has been examined. This is a reissue application of U.S. Patent No. 5,657,447, issued to Leung et al. Claims 1-69 are pending.
2. This application was filed with copies of the printed drawings of the patent in accordance with 37 C.F.R. § 1.174(a). Applicants are reminded that if transfer of the patent drawings to the reissue application is desired, a separate letter requesting transfer of the drawings from the patent file must be filed. See M.P.E.P. § 1413.
3. The preliminary amendment filed April 2, 1999 is informal because the proposed amendments adding claims 40-69 do not comply with 37 C.F.R. § 1.121(e), which sets forth the manner of amending claims in reissue applications. In particular, claims 40-69 are not underlined as required by the rule. See M.P.E.P. § 1453. The claims have been examined but applicants are required to bring claims 40-69 into compliance with 37 C.F.R. § 1.121(e) in any response to this Office Action.
4. The application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

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5. A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

6. The reissue oath/declaration filed with this application is defective because it fails to particularly specify the errors and/or how the errors relied upon arose or occurred as required under 37 CFR 1.175(a)(5). See MPEP § 1414. Included are inadvertent errors in conduct, i.e., actions taken by the applicant, the attorney or others, before the original patent issued, which are alleged to be the cause of the actual errors in the patent. This includes how and when the errors in conduct arose or occurred, as well as how and when these errors were discovered. Applicants' attention is directed to Hewlett-Packard v. Bausch & Lomb, 11 USPQ2d 1750, 1758 (Fed. Cir. 1989). With respect to the declaration filed with the application applicants state only that they claimed less than they were entitled to claim because the patent claims include "various limitations that unduly narrow the scope of the claim", and that new claims "provide a broad recitation of the Applicants' invention." These statements do not *particularly* specify any errors in the patent and do not indicate how the errors arose or occurred.

7. Claims 1-69 are rejected under 35 U.S.C. § 251 as being based upon a defective reissue declaration. The nature of the defects in the declaration are set forth in the discussion above.

Art Unit: 2777

8. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

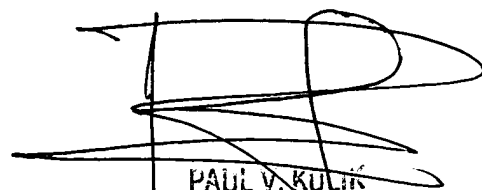
9. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,657,447, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP §§ 1404, 1442.01 and 1442.04.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kulik whose telephone number is (703) 305-3831. The examiner can normally be reached from Monday through Thursday between 8:30am and 6:00pm (EST).

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6606.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

PVK/2-10-00


PAUL V. KULIK
PRIMARY EXAMINER
A-U-2777